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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,820	11/24/2003	Tsutomu Okada	P/3541-50	8000

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EXAMINER

VRETTAKOS, PETER J

ART UNIT PAPER NUMBER

3739

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,820

Applicant(s)

OKADA, TSUTOMU

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

RCE filed 5-31-06.

This action is final.

The application is published application number: 2005/0038424.

This case claims priority to Japanese patent application 2002-341001.

Pending claims are 10-24. Claims 10, 16, 18, 19 and 24 are independent. Claims 1-9 are cancelled. This action is response amendments made 5-31-06.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each of the four claims disclose the neologisms, "returning force" or "naturally tilted" which are not (nor are close variants of the terms) located in Specification. The Applicant is asking the Office to examine claims toward the direction of hidden intangible internal forces ("returning force") that are not even disclosed in the Specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10,12-14,16,18 and 19-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Avitall (5,555,883).

Avitall discloses a device (figures 3a, 6b, and 7a) nearly identical to the Applicant's claimed invention. Avitall discloses a sheath (52), an actuating member (18, *inter alia*), through-hole (76, figure 7) and a naturally tilted wire deployable loop (120, 162).

Note the similarities in the Applicant's figures 1, 2a, 4 and 6 to Avitall's figures 3a, 6b, and 7a.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitall in view of Ellis et al. (6,093,185) or Laufer et al. (6,283,988) or Chia et al. (5,897,554).

Avitall is silent regarding dimensions.

However, several other analogous patented inventions disclose dimensions from which the ordinary user would apply in conjunction with routine experimentation to yield the Applicant's claims. The motivation to perform routine experimentation to determine dimensions would be to design an effective surgical device in light of prior surgical devices. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Avitall in view of Ellis et al. (6,093,185) or Laufer et al. (6,283,988) or Chia et al. (5,897,554) by determining optimal dimensions through routine experimentation.

Response to Arguments

Applicant's arguments filed 5-31-06 have been fully considered but they are not persuasive. Avitall (5,555,883) discloses nitinol/shape memory loops (amongst other elastic materials) in col. 10:1-7 as well as pull wires (24,26)/control wires (124,126) (col. 6:44-52), which anticipates the Applicant's claim language toward a tilted and extendable loop susceptible to a "returning force" or a loop with an elastic deformable portion. The Applicant argues that in contrast, their invention's loop is tilted and extended due to a "built-in 'returning force'". Notwithstanding the term, "built-in" not even being in the claim language, even if it were, Avitall's pull wires (24,26,124,126) that are

"built in" the depicted loop (20,120) in figure 1a provide a "returning force" as they control and permit tilting movements as seen in figure 6b. The Applicant argues that Avitall does not suggest changing the extending direction of the loop due to a returning force. This is wrong. Figure 6b depicts changing the extending direction of the loop 120 due to a returning force **provided by control wires** 124 and 126 (col. 6:38-52). The claim language says nothing specific with regards to what structure provides the returning force, and simply implies it is an inherent characteristic of the loop. This approach does not preclude the Office's assertion that Avitall's loop pull/control wires provide a returning force.

Further reading the Applicant's arguments dated 5-31-06 seems to imply that the Applicant has a very specific definition for the neologism, "returning force". (What does the force return?) Maybe the term indicates that the loop central axis (Applicant's figure 2a, 10c) tilts against the central axis of the actuating member (7a) as seen in figure 2a, but without any external forces at play. In other words, when the loop is extended from shaft 2 it naturally tilts (instead of extending longitudinally with the actuator central axis 7a in parallel.) What is also unfortunate is the that words "return" or "returning" are not in the specification to elaborate why a "returning force" as coined by the Applicant permits the "naturally tilted" loop design in figure 2a. (Note, however, none of the above precludes the Office's apprehension/interpretation of the claims including that the Avitall pull wires provide a "returning force" to the loop.)

The Applicant also argues that the Avitall loop central axis (imaginary line from distal end of element 18 in figure 2d through the proximal end of 22) is not tilted due to a

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returning force or a "natural tilt". Note: "natural tilt" is not defined in the specification.

Although this is not required, and the phrase is commonsensical, its lack of a definition makes it susceptible to alternate interpretations beyond simply what the Applicant chooses. One interpretation is that a "natural tilt" of the loop can occur when a pull wire is tugged as is 26 (element 26 is a *natural* part of the loop as seen in figure 1a) in figure 2d depicting a tilted loop with respect to the longitudinal axis of shaft/catheter 18.

Further, as already established, the presence of pull wires (24,26) indicate the presence of a "returning force" as broadly interpreted. Nothing precludes the Office from asserting that the "natural tilt" seen in figure 2d is simply the result of pulling (providing a returning force) pull wire 26 alone (col. 6:33-36). Again, the Applicant cannot use neologism such as "returning force" and "natural tilt", not define them and expect only one strict interpretation of the phrase. As seen throughout the MPEP, the Examiner is obliged to consider all reasonable interpretations of claim language. The Applicant uses neologisms, does not define them, and resultantly the terms are interpreted broadly. For these reasons the rejections stand.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

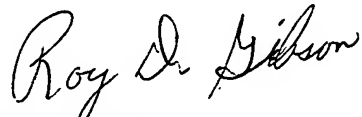
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
July 20, 2006




ROY D. GIBSON
PRIMARY EXAMINER